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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,706	07/13/2001	Masamichi Ito	35.C12551 DI	1058

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EXAMINER	
NEURAUTER, GEORGE C	

ART UNIT	PAPER NUMBER
2158	

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/903,706	ITO ET AL.	
	Examiner	Art Unit	
	George Neurauter	2158	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 30-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 30-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *09/024187* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-18 and 31-40 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For example, the Applicant is referred to claim 15 on page 96 of the disclosure. The claim recites:

> "A data communication apparatus according to claim 14, wherein said control means controls said communication means transmits the still image information by using the first mode when a plurality set of still image information are sequentially transmitted."

The Examiner finds this claim language to be indefinite since it is unclear whether the control means or the communication means is doing the transmitting and is grammatically incorrect.

Also, claim 38 recites:

> "A program for a data communication process stored in a computer readable storage medium, comprising the steps of:
> (a) inputting moving image information and still image information;
> (b) encoding the moving image information and the still image information; and
> (c) transmitting the moving image to a number of unidentified apparatuses and transmitting the still image information to a designated apparatus."

The Examiner also finds this claim language to be indefinite since it is not clear what the Applicant is trying to claim. The Examiner cannot positively determine what the "unidentified" and "designated" apparatuses stand for and the motivation for transmitting a moving image to a plurality of devices and still images to a certain device.

Claim 7 recites:

> "A data communication apparatus according to claim 1, wherein communication using the first mode and communication using the second mode can be mixed in the communication cycle."

The Examiner cannot positively determine what the Applicant means by the communication modes are "mixed".

Claim 16 recites:

"A data communication apparatus according to claim 14, wherein the still image information is contained in the moving image information."

The Examiner cannot determine what the Applicant is trying to claim. It is unclear what the Applicant means that the "still image information is contained in the moving image information."

In view of this indefinite claim language, the claims are subject to an immensely broad interpretation which may encompass a plurality of interpretations and do not distinctly claim the matter that is being claimed.

The Examiner will make his best interpretation of the claims in order to view the application in light of the prior art.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-18 and 31-40 rejected under 35 U.S.C. 102(e) as being anticipated by Hsieh et al [US Patent 5 969 750].

Regarding claim 1, Hsieh discloses a data communication apparatus, comprising:

(a) communication means having a first mode of transmitting information data isochronously with a predetermined communication cycle and a second mode of transmitting information data asynchronously with the predetermined communication cycle; [column 5, lines 38-42; column 6, lines 27-42, specifically lines 36-37; column 7, lines 30-34]

(b) encoding means for encoding the information data by a predetermined encoding method [column 6, lines 32-36; column 7, lines 49-62]; and

(c) control means for controlling said communication means so as to transmit encoded information data when the encoding method corresponds to a decoding method at an object node apparatus and to transmit non-encoded information data when the encoding method does not correspond to the decoding method at the object node apparatus. [column 3, lines 20-43; column 4, lines 12-47; column 7, lines 12-41; column 8, lines 25-67]

Regarding claim 2, Hsieh a data communication apparatus according to claim 1, wherein said control means controls so as to transmit information data encoded by using the first or second mode, when the encoding method corresponds to the decoding method at the object node apparatus. [column 7, lines 12-41; column 8, lines 25-67, specifically lines 48-52]

Regarding claim 3, Hsieh discloses a data communication apparatus according to claim 2, wherein said control means controls so as to transmit by using the first mode when the information data is moving image data. [column 7, lines 12-41]

Regarding claim 4, Hsieh discloses a data communication apparatus according to claim 1, wherein said control means controls so as to transmit information data encoded by using the first or second mode, when the encoding method does not correspond to the decoding method at the object node apparatus. [column 3, lines 20-43; column 7, lines 12-41; column 8, lines 25-67, specifically lines 48-52]

Regarding claim 5, Hsieh discloses a data communication apparatus according to claim 4, wherein said control means controls so as to transmit by using the second mode when the information data is still image data. [column 2, lines 10-28; column 7, lines 12-41]

Regarding claim 6, Hsieh discloses a data communication apparatus according to claim 1, wherein said communication means transmits the information data to the object node apparatus via a data bus. [column 5, lines 20-37]

Regarding claim 7, Hsieh discloses a data communication apparatus according to claim 1, wherein communication using the first mode and communication using the second mode can be mixed in the communication cycle. [column 7, lines 12-41]

Regarding claim 8, Hsieh discloses a data communication apparatus according to claim 1, wherein the first mode has a higher priority over the second mode in the communication cycle. [column 7, lines 12-41, specifically lines 38-41]

Regarding claim 10, Hsieh discloses a data communication apparatus according to claim 1, wherein the non-encoded information data includes information data once encoded and thereafter decoded. [column 1, lines 12-37]

Regarding claim 11, Hsieh discloses a data communication apparatus according to claim 1, wherein the information data contains moving image data or still image data. [column 1, lines 12-20]

Regarding claim 12, Hsieh discloses a data communication apparatus according to claim 1, wherein the data communication apparatus is a digital video camera equipped with an image pickup unit for generating digital image information from an optical image of a subject. [column 1, lines 12-20; column 4, lines 1-11]

Regarding claim 13, Hsieh discloses a data communication apparatus according to claim 1, wherein the data communication apparatus is a video recorder for recording image information encoded by said encoding means in a predetermined storage medium. [column 4, lines 1-11; column 6, lines 27-36; column 7, lines 49-62]

Regarding claim 14, Hsieh discloses a data communication apparatus, comprising:

(a) communication means having a first mode of communication isochronous with a predetermined communication cycle and a second mode of communication asynchronous with the communication cycle; [column 5, lines 38-42; column 6, lines 27-42, specifically lines 36-37; column 7, lines 30-34]

(b) encoding means for encoding image information in accordance with a decoding performance at an object node apparatus, the image information including moving image

information and still image information [column 1, lines 12-20; column 6, lines 32-36; column 7, lines 49-62; column 8, lines 25-67]; and

(c) control means for controlling said communication means so as to transmit the moving image information by using the first mode and to transmit the still image information by using the second mode. [column 2, lines 10-28; column 7, lines 12-41]

Regarding claim 15, Hsieh discloses a data communication apparatus according to claim 14, wherein said control means controls said communication means transmits the still image information by using the first mode when a plurality set of still image information are sequentially transmitted. [column 2, lines 10-28; column 7, lines 12-41]

Regarding claim 16, Hsieh discloses a data communication apparatus according to claim 14, wherein the still image information is contained in the moving image information [column 1, lines 12-37; column 2, lines 10-47, specifically lines 29-43]

Claim 17 is rejected under 35 USC 102(e) since claim 17 contains the same limitations recited in claim 12.

Claim 18 is rejected under 35 USC 102(e) since claim 18 contains the same limitations recited in claim 13.

Regarding claim 30, Hsieh discloses a data communication method, comprising the steps of:

(a) inputting information data;

(b) encoding the information data; and

(c) transmitting decode information containing program codes realizing the decoding method corresponding to an encoding method to be used at said encoding step and transmitting the information data encoded at said encoding step. [column 4, lines 1-23]

Regarding claim 31, Hsieh discloses a data communication method, comprising the steps of:

(a) inputting encoded information data and decode information realizing a decoding process for the information data; and

(b) decoding the encoded information data by using the decode information.[column 1, lines 12-37]

Regarding claim 32, Hsieh discloses a data communication method, comprising the steps of:

(a) encoding information data by using a predetermined encoding scheme;

(b) decoding information data encoded at said encoding step; and

(c) selecting an output of either the encoded information data or the decoded information data in accordance with whether the encoding scheme corresponds to a decoding scheme at an object node apparatus. [column 3, lines 20-43; column 4, lines 12-47; column 7, lines 12-41; column 8, lines 25-67]

Claim 33 is rejected under 35 USC 103(a) since claim 33 contains the same limitations recited in claim 1.

Regarding claim 34, Hsieh discloses a data communication system having a first mode of communication isochronous with a predetermined communication cycle and a second mode of

communication asynchronous with the communication cycle, [column 5, lines 38-42; column 6, lines 27-42, specifically lines 36-37; column 7, lines 30-34]

wherein moving image information encoded in accordance with a decoding performance at an object node apparatus is transmitted by using the first mode and still image information encoded in accordance with the decoding performance at the object node apparatus is transmitted by using the first or second mode. [column 2, lines 10-28; column 7, lines 12-41]

Claim 35 is rejected under 35 USC 103(a) since claim 35 contains the same limitations recited in claim 30.

Regarding claim 36, Hsieh discloses a program for a data communication process stored in a computer readable storage medium, comprising the steps of:

(a) encoding information data by a predetermined encoding method;

(b) transmitting encoded information data isochronously with a predetermined communication cycle when the encoding method corresponds to a decoding method at an object node apparatus; and

(c) transmitting non-encoded information data asynchronously with the communication cycle when the encoding method does not correspond to the decoding method at the object node apparatus. [column 3, lines 20-43; column 4, lines 12-47; column 7, lines 12-41]

Claim 37 is rejected under 35 USC 103(a) since claim 37 contains the same limitation recited in claim 33.

Regarding claim 38, Hsieh discloses a program for a data communication process stored in a computer readable storage medium, comprising the steps of:

(a) inputting moving image information and still image information;

(b) encoding the moving image information and the still image information; and

(c) transmitting the moving image to a number of unidentified apparatuses and transmitting the still image information to a designated apparatus. [column 4, lines 12-47; column 5, lines 20-55; column 6, lines 27-42]

Claim 39 is rejected under 35 USC 103(a) since claim 39 contains the same limitations recited in claim 30.

Claim 40 is rejected under 35 USC 103(a) since claim 40 contains the same limitations recited in claim 31.

Claim 41 is rejected under 35 USC 103(a) since claim 41 contains the same limitations recited in claim 32.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Hsieh et al. in view of "IEEE Standard for a High Performance Bus" (hereinafter "IEEE 1394")

Regarding claim 9, Hsieh discloses a data communication apparatus according to claim 1.

Hsieh does not expressly disclose wherein the the first mode is the IEEE 1394 isochronous mode and the second mode is the IEEE 1394 asynchronous mode, however, Hsieh does disclose using a isosynchronous and synchronous mode using the USB serial bus [column 5, lines 20-42]

"IEEE 1394" wherein the first mode is in conformity with an isochronous transmission mode of IEEE 1394 specifications, and the second mode is in conformity with an asynchronous transmission mode of IEEE 1394 specifications. [page 21, "3.4.1 Data Transfer Services"]

It would have been obvious to one skilled in the art at the time the invention was made to use the apparatus as described in Hsieh regarding claim 1 with the IEEE 1394 isosynchronous and asynchronous transmission modes as described in "IEEE 1394". "IEEE 1394" discloses that the invention is a serial bus that features high speeds and low costs [page 1, "1.1 Scope"]. It would have been obvious to use this higher speed serial bus along with the teachings of Hsieh. Therefore, it would have been obvious to achieve the limitations as described in claim 9.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following US Patent teaches the state of the art in downloading programs from a digital camera to another device:

US Patent 6 003 065 to Yan et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Neurauter whose telephone number is 703-305-4565. The examiner can normally be reached on Mon-Fri 8am-4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

gcn
September 26, 2002

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100